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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,245	01/11/2002	John J. Donahue	011684.00009	7433

22907 7590 05/09/2005

BANNER & WITCOFF  
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WASHINGTON, DC 20001

EXAMINER
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GREENE, DANIEL L

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	Applicant(s)
10/042,245	DONAHUE, JOHN J.
Examiner	Art Unit
Daniel L. Greene	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 11 January 2002.  
2a) This action is FINAL.      2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-63 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) \_\_\_\_\_ is/are allowed.  
6) Claim(s) \_\_\_\_\_ is/are rejected.  
7) Claim(s) \_\_\_\_\_ is/are objected to.  
8) Claim(s) 1-63 are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on 04 April 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)

## DETAILED ACTION

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 22, 35, and 44, drawn to negotiating a contract over a computer network between a first negotiator and a second negotiator, classified in class 705, subclass 80.
  - II. Claim 10, drawn to assigning for each of a plurality of contract phases, information identifying a person or entity having authority to negotiate a corresponding contract phase, and a role played by that person or entity, classified in class 707, subclass 1.
  - III. Claim 20, drawn to messaging functions that permits participants to selectively transmit messages, classified in class 340, subclass 310.
  - IV. Claim 21, drawn to customizing function that permits one of the users to selectively exclude one or more of the predetermined agreement provisions from being displayed , classified in class 715, subclass 512.
  - V.. Claims 15, and 50, drawn to generating a report that includes, different transactions, identifying contracts and current contact person for each respective transaction, and, in response to selecting one of the current contact persons, generating a message to the one current person, classified in class 283, subclass 54.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II, III, IV and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).
3. In the instant case, Invention I has separate utility such as negotiating a transaction over a computer network that provides the selections of predefined provisions with agree/defer options.
4. Invention II has a separate utility such as designating for each of a plurality of contract phases, information identifying a person or entity having authority to negotiate a corresponding contract phase, a role played by that person or entity and, denying persons or entities the right to negotiate in contract phases they are not authorized to negotiate in.
5. Invention III has a separate utility such as providing a dual-messaging function that permits members of a transaction team authorized to act on behalf of one of the negotiators to transmit messages to other members of the transaction team that are recorded in the message log that can be viewed by all the members of the transaction team, and permits members of the transaction team to selectively transmit messages to other members of the transaction team that are not recorded in the message log, such that they cannot be viewed by all members of the transaction team.
6. Invention IV has a separate utility such as providing a customization function that permits one of the negotiators to, prior to displaying on a first computer screen a

plurality of predefined contract provisions, selectively exclude one or more of the predetermined agreement provisions from being displayed.

7. Invention V has a separate utility such as generating a summary report that includes, for each of the plurality of different transactions, information identifying the contract and a current contact person for each respective transaction and information received from evaluation forms.

8. See MPEP & 806.05(d)

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by the different classifications, restriction for examination purposes as indicated is proper.

10. A telephone call was made to Bradley C. Wright on 4/28/2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 571-272-6707. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone

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Art Unit: 3621

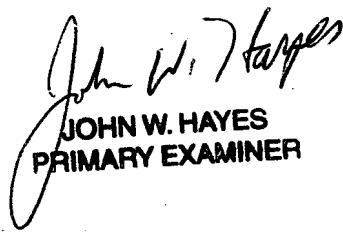
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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel L. Greene  
Examiner  
Art Unit 3621

4/28/2005

  
JOHN W. HAYES  
PRIMARY EXAMINER